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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/402,702

Applicant(s)

CAZIN, DOMINIQUE

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 6/17/03, and has been entered and made of record. Currently, **claims 1 and 3-7** are pending.

Claim Objections

2. **Claim 1** is objected to because of the following informalities:

In **claim 1**, line 15, "receipt if the fax" should read "receipt of the fax".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. **Claims 1, and 3-7** are rejected under 35 U.S.C. 102(e) as being anticipated by Rachelson (U.S. Patent Number 6,157,706).

Regarding *claim 1*, Rachelson discloses a fax machine (see Figs. 1, and 4(A)-4(C)) designed to be connected to a telephone network and to communicate with a corresponding fax machines across a computer network of the Internet type (see Figs. 1, and 4(A)-4(C)), the fax machines each having an electronic address on the aforesaid computer network (column 6, lines 45 through 64), characterized by the fact that it has memory means for storing a record of the fax machine communications with corresponding fax machines (Address Book, column 8, lines 4 through 28), containing the electronic addresses of the aforesaid corresponding fax machines (column 8, lines 32 through column 48), means for managing the record, for extracting the electronic addresses and associating them with the corresponding fax machines (column 13, lines 14 through 38) and means for asking a corresponding fax machine for its electronic address, during a communication with the aforesaid corresponding fax machine across the telephone network (column 8, lines 4 through 48), the aforesaid means for managing the record being adapted for entering the aforesaid electronic address of the corresponding fax machine into the record (column 8, lines 4 through 48), and in which means being provided to receive a fax transmitted from a corresponding fax machine across the aforesaid computer network and associated with the electronic address on the computer network of the corresponding fax machine (column 7, lines 7 through 25), the means for managing the record are organized, upon

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the receipt of the fax, to enter the electronic address of the aforesaid corresponding fax machine into the record (column 8, lines 10 through 14).

Regarding *claim 3*, Rachelson discloses the fax machine discussed above in claim 1, and further teaches of means being provided to send to a corresponding fax machine, via the computer network, a fax associated with the electronic address on the computer network of the corresponding fax machine (column 6, line 45 through column 7, line 25), the means for managing the record are adapted to enter the electronic address of the aforesaid corresponding fax machine into the record prior to sending the fax (see Fig. 6, column 8, lines 3 through 64).

Regarding *claim 4*, Rachelson discloses the fax machine discussed above in claim 1, and further teaches that since each electronic address contains identification data (see Fig. 9(A), column 8, lines 15 through 28), the means for managing the record are organized to extract the aforesaid identification data from each address of a corresponding fax machine and to associate the data with aforesaid address in the record (column 8, lines 4 through 48).

Regarding *claim 5*, Rachelson discloses the fax machine discussed above in claim 4, and further teaches that the means for managing the record are organized to compare the identification data extracted from each new electronic address relating to a corresponding fax machine with the identification data associated with the electronic addresses stored in the record in order to check whether the aforesaid identification data is already associated with the electronic address in the record (column 8, lines 4 through 48, and column 13, lines 14 through 38).

Regarding *claim 6*, Rachelson discloses the fax machine discussed above in claim 5, and further teaches that the identification data extracted from the new electronic address is already

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associated with an electronic address in the record, the means for managing the record are organized to compare the electronic address held in the record with the new electronic address and, where they are not identical, to replace the former with the latter in the record (column 8, lines 29 through 48).

Regarding *claim 7*, Rachelson discloses the fax machine discussed above in claim 1, and further teaches since the memory means have a limited storage capacity (column 8, lines 15 through 19), when the aforesaid memory means are full, the means for managing the record are organized to erase the oldest electronic address in the memory means prior to entering a new electronic address (column 8, lines 39 through 48, wherein the user would remove an oldest address, and then add a newer address).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J. R. P.

Joseph R. Pokrzywa
Examiner
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jrj


EDWARD L. COLES
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